

### SECTION III—REMARKS

This amendment is submitted in response to the Office Action mailed February 22, 2005. Claims 1, 9 and 16 are amended herein, and claims 1-22 remain pending in the application. Applicant respectfully requests reconsideration of the application and allowance of all pending claims in view of the above amendments and the following remarks.

#### Rejections Under 35 U.S.C. § 102

The Examiner rejected claims 1, 3, 9-10 and 12-13 as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 6,178,044 to Li *et al.* (“Li”). Applicant respectfully traverses the Examiner’s rejections. A claim is anticipated only if each and every element, as set forth in the claim, is found in a single prior-art reference. MPEP § 2131; *Verdegaal Bros. v. Union Oil of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). As explained below, Li cannot anticipate these claims because it does not disclose every element and limitation recited therein.

Claim 1, as amended, recites an optical isolator combination including an input, an output, and a phase retardation plate positioned at the input, “wherein the phase retardation plate is the first polarization-modifying component encountered by an optical signal entering through the input.” In the optical circulator of Li, a signal enters the circulator through input 102, but it encounters polarizer 108 and Faraday rotator 110 before it ever encounters the paired phase retardation plates 112. Similarly, a signal entering the circulator through input 128 encounters a polarizer 122 before it encounters the pair of phase-retardation plates 120. Li therefore cannot disclose a combination including the claimed limitations, because in either case the phase retardation plate of Li is not “the first polarization-modifying component encountered by an optical signal entering through the input.” Applicant submits that Li therefore cannot anticipate the claim, and respectfully requests withdrawal of the rejection and allowance of the claim.

Regarding claim 3, if an independent claim is allowable then any claim depending therefrom is also allowable. *See generally* MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 1 is in condition for allowance. Applicant respectfully submits that claim 3 is therefore allowable by virtue of its dependence on an allowable independent claim, as well as by virtue of the features recited therein. Applicant respectfully requests withdrawal of the rejections and allowance of these claims.

Claim 9, as amended, recites a process combination including rotating a polarization of an optical signal using a phase retardation plate, “wherein the phase retardation plate is the first polarization-modifying component encountered by the optical signal.” By analogy to the discussion above for claim 1, Li cannot disclose a combination with the claimed limitations because it does not disclose, teach or suggest that a phase retardation plate is “the first polarization-modifying component encountered by the optical signal.” Applicant submits that Li therefore cannot anticipate the claim, and respectfully requests withdrawal of the rejection and allowance of the claim.

Regarding claim 12-13 if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 9 is in condition for allowance. Applicant submits that claims 12-13 are therefore allowable by virtue of their dependence on an allowable independent claim, as well as by virtue of the features recited therein. Applicant respectfully requests withdrawal of the rejections and allowance of these claims.

### Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 2, 4-8, 11 and 14-15 and 16-22 under 35 U.S.C § 103(a) as obvious in view of, and therefore unpatentable over, Li alone or in combination with the Applicant's disclosure of prior art. Applicant respectfully traverses the Examiner's rejections.

Regarding claims 2, 4-8, 11 and 14-15, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claims 1 and 9 are in condition for allowance. Applicant submits that claims 2, 4-8, 11 and 14-15 are therefore allowable by virtue of their dependence on allowable independent claims, as well as by virtue of the features recited therein. Applicant respectfully requests withdrawal of the rejections and allowance of these claims.

As to claim 16, to establish a *prima facie* case of obviousness, the Examiner must establish that three criteria are met: (1) the prior art references must teach or suggest all the claim limitations; (2) some suggestion or motivation to combine the references must be found in the prior art; and (3) there must be a reasonable expectation of success. MPEP § 2143. As explained below, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness.

Claim 16, as amended, recites a system combination including an optical signal source and an optical isolator having an input and an output, the optical signal source being coupled to the input, and the optical isolator comprising a phase retardation plate positioned at the input, wherein "the phase retardation plate is the first polarization-modifying component encountered by the optical signal." By analogy to the discussion above for claim 1, Li does not disclose, teach or suggest a combination where the phase retardation plate "is the first polarization-

modifying component encountered by the optical signal.” Therefore, even when combined with the prior art disclosure of the present application, the combination does not disclose, teach or suggest every element and limitation of the claim. Applicant submits that the combination of Li with the prior art disclosure of the present application cannot obviate the claim, and respectfully requests withdrawal of the rejection and allowance of the claim.

Regarding claims 17-22, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 16 is in condition for allowance. Applicant respectfully submits that claims 17-22 are therefore allowable by virtue of their dependence on an allowable independent claim, as well as by virtue of the features recited therein. Applicant respectfully requests withdrawal of the rejections and allowance of these claims.

#### Conclusion

Given the above amendments and accompanying remarks, all claims pending in the application are in condition for allowance. If the undersigned attorney has overlooked a teaching in any of the cited references that is relevant to allowance of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 292-8600.

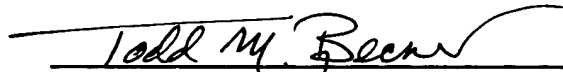
Charge Deposit Account

Please charge our Deposit Account No. 02-2666 for any additional fee(s) that may be due in this matter, and please credit the same deposit account for any overpayment.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: 5-19-05

  
\_\_\_\_\_  
Todd M. Becker  
Attorney for Applicant(s)  
Registration No. 43,487

Blakely, Sokoloff, Taylor & Zafman LLP  
12400 Wilshire Boulevard, Seventh Floor  
Los Angeles CA 90025-1030  
Phone: 206-292-8600  
Facsimile: 206-292-8606

Enclosures: Postcard  
Amendment transmittal, in duplicate